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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,854	02/25/2002	Teruo Ouchi	P21664	3850
7055	7590	01/06/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 01/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/081,854

Applicant(s)

OUCHI, TERUO

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Applicant's election with traverse of Group II, claims 8-19 and 26, and species I, claims 8-18 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there would not be a "serious burden" if all inventions were to be examined in one application. This is not found persuasive because Applicant has not provided any evidence of this. Instead, Applicant assumes a coextensive or significantly overlapping search for all inventions. However, if Applicant even bothered to investigate such searches, Applicant would have realized that there is no "significant" overlap. For instance, the measurement device of claim 1 does not require a bending mechanism (and especially the specific one claimed in claim 8). Therefore, none of the multiple subclasses relating to bending mechanisms (which is critical to claim 8) would have to be searched. It is noted that the application of such requirement affects both search and examination of the claimed patentably distinct inventions. Therefore, as much as the search for the distinct inventions might overlap to a certain extent, there still exists the burden of separate analysis of the prior art references for each distinct invention, as well as a separate written analysis in the Office Action. Since the Examiner is only given time to search and examine one invention per application, searching multiple inventions in one application is a "serious burden".

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-7 and 19-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Objections***

4. Claim 14 is objected to because of the following informalities: in claim 14, term “position” should be “positions”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8, 10, 11, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 8, 10, 11, 15, and 16, term “flexible tube” lacks antecedent basis. This should be “flexible tubular member”.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 8-10 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Doi et al. (U.S. Pat. 5,058,603).

Doi et al. disclose a flexible tubular member (1) with gradations (4), a V-shaped groove (2) and a operation wire (10) in and movable relative to the flexible tubular member and secured at the distal end (12). Note injection mouth (17) in Figure 11. Lumen extending to distal end (1a) which is connected to injection mouth (17) forms a tissue collecting device since the lumen can accommodate tissue matter upon application of a suction (note a syringe is connected to injection mouth 17, col.14, lines 15-17).

9. Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hart (U.S. Pat. 5,284,128).

Hart discloses a flexible tubular member (30) having a V-shaped groove (70), a operation wire (61) movable relative to and secured to the flexible tubular member. Note a tissue collecting device is secured at the distal end (141, Fig. 15).

***Allowable Subject Matter***

10. Claims 11-15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

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11. The following is a statement of reasons for the indication of allowable subject matter: Claim 11 recites a combination of elements wherein the operation wire runs outside the tubular member through and between the pair of grooves. The prior art of record either shows the operation wire running outside the pair of grooves through separate holes (Mitsuda et al., U.S. Pat. 6,013,024; Emerson, U.S. Pat. 4,353,358) or only through one groove (Doi et al., U.S. Pat. 5,058,603).

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

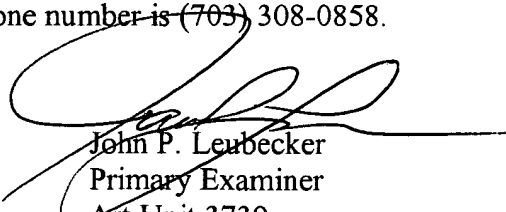
Bonnet (U.S. Pat. 4,653,476)  
Sadamasu (U.S. Pat. 6,017,339)  
Chikama (U.S. Pat. 5,520,222)

Adler et al. (U.S. Pat. 6,248,062)  
Sosnowski et al. (U.S. Pat. 4,911,148)  
Brennen et al. (U.S. Pat. 5,873,842)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl